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PATENT
Docket No. H 5322 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kelders et al.
Appl. No.: 09/992,861 Examiner: Linda L. Gray
Filed: November 14, 2001 Art Unit: 1734
Customer No.: 00423
Title: APPARATUS FOR DISPENSING A ROLL OF MATERIAL
AND METHOD OF USING THE SAME

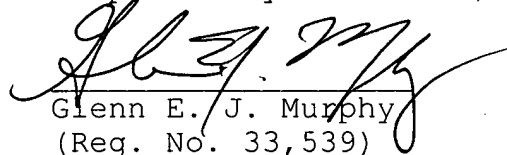
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APPEAL BRIEF TRANSMITTAL

Appellant's brief, in triplicate, is transmitted herewith in accordance with 37 C.F.R. § 1.192. Please charge the required fee of \$330.00 to our Deposit Account No. 01-1250. Order No. 04-0183.

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Respectfully submitted,


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APPLICANTS' APPEAL BRIEF

Applicants appeal under 37 C.F.R. § 1.192(a) from the Final Office Action of October 20, 2003. A Notice of Appeal, the appeal fee under 37 C.F.R. § 1.17(b), and a (2) Months Extension of Time were filed on March 10, 2004.

I. Real Party In Interest

The real party in interest in this appeal is the assignee, Henkel Kommanditgesellschaft auf Aktien (Henkel KGaA).

II. Related Appeals and Interferences

There are no related appeals or interferences known to applicants, assignee, or their legal representatives that will directly affect or be directly affected by or that have a bearing on this appeal.

III. Status of the Claims

The pending claims are 1, 3-8, and 10-20; claims 2 and 9 were canceled during prosecution. All of the pending claims 1, 3-8, and 10-20 are under final rejection and are appealed. The pending claims appear in the Appendix to this Brief.

IV. Status of Amendments

The amendment filed January 20, 2004, responding to the final office action mailed October 20, 2003 has been entered, as were all prior amendments.

V. Summary of Invention

This application claims an apparatus for dispensing a roll of material that includes an enclosable housing (12) having a dispensing end (20) and a hinge end (18). Spec. p. 4, ll. 4-11. The housing includes a roll holding piece (14) for holding a roll of material that preferably has a bottom (48), two opposing sidewalls (34), and a discharge end (20B); a cover piece (16) that preferably has a top (39), two opposing sidewalls (38), a discharge end (20A), and at least one depression (78) for placement of a finger;

a hinge assembly (22) for joining the roll holding piece (14) and cover piece (16) at the hinge end (18), where the hinge assembly (22) is capable of opening the housing (12) while the cover piece (16) and roll holding piece (14) remain connected by the hinge assembly (22). Spec. p. 4, line 11 to p. 5, line 11. The housing (12) also includes an applicator (30) located proximate to the dispensing end (20) for applying material to a substrate; a discharge opening (26) for the material located proximate to the dispensing end (20); and a cutting member (28) located proximate to the dispensing end (20) for cutting the material. Spec. p. 4, lines 11-17. The apparatus is especially suited for applying rolls of pressure sensitive adhesive tape and is preferably used in one hand.

VI. Issues

- I. (Claims 1, 3-8, 10-20) Whether U.S. 2,584,065 (Taylor) teaches or suggests the claimed cover piece having at least one depression on top for placement of a finger?
- II. (Claim 14) Whether U.S. 2,584,065 (Taylor) teaches the claimed cover piece having one or more depressions on the sidewalls for placement of a thumb or fingers?

VII. Grouping of Claims

Claims 1, 3-8, 10-13, and 15-20 stand or fall together in this appeal; an additional and separate ground for patentability of claim 14 is asserted.

VIII. Argument

- I. (Claims 1, 3-8, 10-20) Whether U.S. 2,584,065 (Taylor) teaches or suggests the claimed cover piece having at least one depression on top for placement of a finger?

Claims 1, 3-8, 10, 12-14, and 16-20 stand rejected as anticipated by U.S. 2,584,065 (Taylor). Claims 11 and 15 stand rejected as obvious over Taylor in view of U.S. 3,895,059 (Link). Claims 7 and 8 stand rejected as obvious over Taylor alone. The issue in these rejections for review is, does U.S. 2,584,065 (Taylor) teach or suggest the top of the cover piece having at least one depression for placement of a finger? Applicants contend Taylor does not.

Taylor shows a tape dispenser having a housing with an upper cover piece. See Taylor, Figures 1 to 4. In the side view Figure 1, the upper cover (2) forms in profile a bulb or teardrop shape covering the roll of material on one end of the dispenser, and opposite the bulbous end, a narrower dispensing end. The profile of the top surface of the cover (2) from the bulbous end becomes straight and flat as it approaches the transition to the dispensing end. Likewise, the contour of the cover (2) on the dispensing end has a generally flat profile. These two generally flat portions meet in a concave arc. As seen in top view Figure 4 and cut-away side view Figure 5, the cover piece (2) has

an opening (32) in the arc that joins the two flat profiles from each end. The feed roller (9) and ring (11) project through the opening (32) in the cover piece (2), which occupies the whole of what would be the top surface of the cover (2) in the arc between the two flat surfaces approaching from either end.

The opening (32) in Taylor's cover (2) enables a user to access the feed roller (9) with a thumb to advance a new supply of tape out of the dispensing end after the prior piece has been cut. Taylor, col. 3, line 66 to col. 4, line 7. A user must access the feed roller (9) to advance the tape each time the dispenser is used because the device severs the discharged tape inside the pocket (18) of the cover piece (2), where the cut-off blade (19) is located. Taylor, col. 3, lines 4-6. Thus, unless the user advances the tape with the feed roller (9) through the opening (32) in the cover piece (2), one cannot reach the tape end to begin the next use without opening the cover.

Taylor's opening (32) is structurally different from the claimed depression in that it does not form part of the cover upon which the user places a finger. The depression of Applicants' claims enables the user to comfortably grasp Applicants' device and to dispense material using one hand. Spec., p. 10, ll. 5-8, 17-20. Preferably the index finger, for example, "may rest comfortably on the depression," and in a preferred embodiment, the depression may have ridges on its surface. Spec., p. 10, ll. 16, 20 (emphasis added).

Thus applicants' depression on top is part of the cover, which the opening in Taylor is not.

What the Examiner calls a "depression" in Taylor is in fact a hole through its cover "through which the peripheral portions of the feed roller 9 and ring 11 project for engagements by the operator's thumb." Taylor, col. 3, lines 47-50. Applicants' depression, unlike Taylor's hole, has a surface upon which "the index finger can rest comfortably." Spec., p. 10, line 19. Taylor's hole has no surface.

The claimed and prior art structures function differently. The user's thumb in Taylor contacts the roller and ring projecting through the hole not to "rest comfortably" but to move these elements. Resting a finger or thumb in this hole during dispensing would stop the feed roller and prevent discharge of the tape from the supply roll during application to a substrate. This access hole for intermittently operating the feed roller does not provide a surface upon which to comfortably rest a finger. It is structurally and functionally different from what is claimed. Thus Taylor does not describe a depression for placement of a finger on top of the cover as claimed.

The Examiner grants that placing a finger in the opening on the Taylor device would result in contact with the feed roller, but answers Applicants' claims do not exclude such contact. Yet the claims need not exclude such contact, where the prior art fails to disclose the claimed

structure. The Examiner also says that the term "depression" encompasses a hollow hole as disclosed in Taylor. But the term "depression" is not interpreted in a vacuum. When construed in light of its disclosure at page 10, lines 17-20, it is clear that a depression on the cover that can have ridges and upon which a finger may rest comfortably has a surface that is part of the cover that is not described by the hole taught in Taylor. For these reasons the final rejections of claims 1, 3-8, 10, 12-14, and 16-20 as anticipated by U.S. 2,584,065 (Taylor) should be reversed.

The rejections of claims 11 and 15 as obvious over Taylor in view of U.S. 3,895,059 (Link) and claims 7 and 8 as obvious over Taylor address the limitations of these dependent claims, but are defective since neither Taylor, nor Link, nor any other art of record would have suggested the top depression to one of skill. The hole of Taylor does not suggest applicants' top depression. One would not rest one's finger on a mechanism used only periodically (i.e., for rolling the feed roller (9)) and where doing so would stop the tape supply and render the device inoperative.

It is conceivable that a user could place a finger on either side of Taylor's hole and avoid contact with the feed roller, but if so that finger would contact the cover (2) on a relatively flat surface and not a depression as claimed. A depression could be added to the top cover, but there is no suggestion in the references to do so. One of

skill would not have modified Taylor's "depression" to provide a resting place for a finger, since covering or closing the opening (32) to provide a finger resting place would impair access to the feed roller through the opening (32), which is necessary to the explicit object of Taylor's invention - to provide for one-handed feeding, applying, and cutting of tape. Taylor, col.1, lines 6-29. The art cannot be modified to render it unsuitable for its intended purpose. M.P.E.P. § 2143.01.

Indeed, one could speculate almost endlessly about what *might* or *could* be done to the Taylor device to reach what Applicants claim, but the problem is that none of those solutions find any support in the record. Therefore Applicants' claims 11 and 15 are not obvious over Taylor in view of U.S. 3,895,059 (Link), nor are claims 7 and 8 obvious over Taylor alone.

II. (Claim 14) Whether U.S. 2,584,065 (Taylor) teaches the claimed cover piece having one or more depressions on the sidewalls for placement of a thumb or fingers?

Claim 14 was rejected as anticipated by Taylor on the additional ground that Taylor's Figure 3 shows "that the sidewalls of cover 2 are depressed on both sides for placement of one's finger and/or thumb, i.e., depressed in that the edges of the top are in a different plane than the bottom edges of the two sides." Taylor's Figure 3 does not

show depressions to help grip the device with the thumb and forefinger as claimed. Spec. p. 13, ll. 9-12.

How the cited structures in Taylor were intended to be used is not explained in the reference itself, but the manner of use inherent in the Examiner's interpretation of Figure 3 makes no sense. Figure 3 shows an end view of long, narrow indentations on either top edge of the cover piece. This end view distorts the true proportions of the indentations, which are apparent when one looks at the side view in Figure 1. There it is seen that the area of these "depressions" is far too narrow to fit a finger. A user attempting to grasp the device between the thumb and middle or forefinger by these indentations on the cover would gain no hold from the indentations and be unable to support or usefully manipulate with their other fingers the vast balance of the device that remains. It is an object of Taylor to avoid "the inability of a user to fully manipulate the device with the hand that holds it." Taylor, col. 2, ll. 7-11.

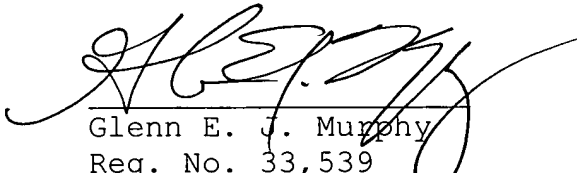
Holding the Taylor device in the manner suggested by the rejection of claim 14 also directly contradicts Taylor's explicit teaching of how its device is held. The user cannot grasp the device between thumb and finger(s) on the cover indentations and at the same time access the opening (32) with the thumb, without first holding the device in the other hand and defeating the object of one-

handed feeding, applying, and cutting of tape.¹ Taylor, col. 1, lines 6-10, col. 3, lines 46-50. For these reasons, Figure 3 of Taylor does not disclose one or more depressions on the sidewalls for placement of a thumb or fingers to anticipate claim 14.

CONCLUSION

For the reasons stated above, Applicants respectfully ask that the Examiner's final rejections of claims 1, 3-8 and 10-20 be reconsidered and reversed. Should any fees be due for entry and consideration of this Brief that have not been accounted for, the Commissioner is authorized to charge them to Deposit Account No. 01-1250.

Respectfully yours,


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¹ Indeed, the interpretation of Taylor in the rejection of claim 14 cannot be squared with the Examiner's reliance on Taylor to reject claims 1, 3-8, and 10-20 as anticipated, since the thumb cannot at the same time grasp the cover on the side "depressions" and be placed in the top "depression."

APPENDIX

Listing of Claims:

1. An apparatus for dispensing a roll of material comprising an enclosable housing having a dispensing end and a hinge end and comprising

(a) a roll holding piece for holding a roll of material, the roll holding piece having a bottom, two opposing sidewalls, and a discharge end;

(b) a cover piece, the cover piece having a top, two opposing side walls, and a discharge end, wherein the top of the cover piece has at least one depression for placement of a finger;

(c) a hinge assembly for joining the roll holding piece and the cover piece at the hinge end, wherein the hinge assembly permits opening of the housing while the cover piece and roll holding piece remain connected by the hinge assembly;

(d) an applicator located proximate to the dispensing end for applying material to a substrate;

(e) a discharge opening for the material located proximate to the dispensing end; and

(f) a cutting member located proximate to the dispensing end for cutting the material.

3. The apparatus of claim 1 further comprising a latching assembly having opposing latching shoulders extending from the bottom of the roll holding piece for securing the cover piece to the roll holding piece.

4. The apparatus of claim 1 wherein the applicator is located on the cover piece proximate to the discharge end of the cover piece and the applicator is rotatable or stationary on the cover piece.

5. The apparatus of claim 4 wherein the discharge opening is located between the applicator and the discharge end of the roll holding piece.

6. The apparatus of claim 1 wherein the cutting member is located on the cover piece proximate to the discharge end of the cover piece.

7. The apparatus of claim 1 wherein the interior surface of the bottom of the roll holding piece has one or more ridges, surface roughening, or a combination thereof, for preventing the material from adhering to the interior surface of the bottom.

8. The apparatus of claim 7 wherein the exterior surface of the bottom of the roll holding piece has one or more ridges, surface roughening, or a combination thereof for preventing the material from adhering to the exterior surface of the bottom.

10. The apparatus of claim 1 wherein the sidewalls of the cover piece have at least two side depressions for placement of a finger or thumb.

11. The apparatus of claim 1 wherein the bottom of the roll holding piece has one or more feet for resting the apparatus on a surface.

12. An apparatus for dispensing a roll of material comprising an enclosable housing having a dispensing end and a hinge end and comprising

(a) a roll holding piece for holding a roll of material that has a bottom, two opposing sidewalls, and a discharge end;

(b) a cover piece that has a top, two opposing sidewalls and a discharge end, wherein the top of the cover piece has at least one depression for placement of a finger;

(c) a hinge assembly for joining the roll holding piece and cover piece at the hinge end, wherein the hinge assembly permits opening of the housing while the cover piece and roll holding piece remain connected by the hinge assembly;

(d) a latching assembly having opposing latching shoulders extending from the roll holding piece for securing the cover piece to the roll holding piece;

(e) an applicator located on the cover piece and proximate to the discharge end of the cover piece for applying material to a substrate;

(f) a discharge opening for the material located between the applicator and the discharge end of the roll holding piece; and

(g) a cutting member located on the cover piece proximate to the discharge end of the cover piece for cutting the material.

13. The apparatus of claim 12 wherein the interior surface, the exterior surface, or both of the bottom of the roll holding piece has one or more ridges, surface roughening, or combinations thereof, for preventing the material from adhering to the surfaces of the bottom.

14. The apparatus of claim 13 wherein the cover piece has one or more depressions on the sidewalls for placement of a thumb or fingers.

15. The apparatus of claim 14 wherein the bottom of the roll holding piece has one or more feet for resting the apparatus on a surface.

16. A method of dispensing a roll of material comprising:

(a) providing an apparatus for dispensing a roll of material wherein the apparatus comprises an enclosable housing having a dispensing end and a hinge end and comprising

(i) a roll holding piece for holding a roll of material and having a discharge end;

(ii) a cover piece that has a top, two opposing sidewalls, and a discharge end, wherein the top of the cover piece has at least one depression for placement of a finger;

(iii) a hinge assembly for joining the roll holding piece and cover piece at the hinge end, wherein the hinge assembly permits opening of the housing while the

cover piece and roll holding piece remain connected by the hinge assembly;

(iv) an applicator located proximate to the dispensing end;

(v) a discharge opening for the material located proximate to the dispensing end; and

(vi) a cutting member located proximate to the dispensing end;

(b) mounting a roll of material in the roll holding piece of the housing; and

(c) applying the material to a substrate by pressing the material onto a substrate using the applicator.

17. The method of claim 16 wherein the mounting of the roll of material is carried out in a manner so that the material extends through the discharge opening and at least partially against the applicator when the housing is closed.

18. The method of claim 16 further comprising cutting the material with the cutting member to separate the roll of material from the material applied to the substrate.

19. The method of claim 16 wherein the material is pressure sensitive adhesive tape or a transfer adhesive film.

20. The method of claim 16 wherein the dispenser is held in a hand during the applying of the material to the substrate.